

REMARKS

Claims 21 and 22 were cancelled previously. Claims 4-7, and 13-16 were cancelled herein. Claim 18 has been withdrawn. Claims 1, 8-10, 12, and 20 are amended herein. No new matter is added by these amendments.

With these amendments, claims 1-3, 8-12, 17, 19, and 20 are pending.

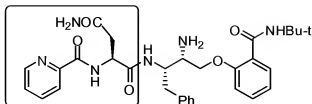
Provisional non-statutory obviousness-type double patenting

Claims 1, 4, and 5-13 have been provisionally rejected for obviousness-type double patenting in view of U.S. Application No. 10/543,385 ('385 application). Applicants respectfully disagree.

The '385 application claims the compound where R_n is $Ar-W-N(Z)-CH(Q)-C(O)-$, and where W is $-C(O)-$ or $-SO_2-$. As amended, claim 1 encompasses compounds where R_n is defined as R'_{100} , $-(CRR')_{1-6}R'_{100}$, or $-C(=O)-(CRR')_{0-6}R_{100}$. In particular, the amended claims do not allow for $-W-N(Z)-$ linkage for R_n . The subject matter of the amended claims is not suggested by the '385 application. Therefore, the subject matter of amended claim 1, and dependent claims 8-13 is not encompassed, or rendered obvious, by the '385 patent claims.

Rejections under 35 U.S.C. § 103(a)

Claims 1, and 5-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett et al. in view of Patani et al. In particular, Bennett teaches compound H, which can be represented by the following structure. For the Examiner's convenience, Applicants have boxed the substituent said to correspond to the R_n group in the pending claims.



The Office notes that the difference between the prior art and the claimed compounds is the teaching of moiety Y, which is equal to pyridyl in Bennett and is equal to phenyl in the current claims. The Office further relies on Patani which teaches that "phenyl is bioisosteric replacement of pyridyl." Applicants respectfully disagree.

As noted above, claim 1 has been amended to recite encompass compounds where R_n is defined as R'_{100} , $-(CRR')_{1-6}R'_{100}$, or $-C(=O)-(CRR')_{0-6}R'_{100}$. In particular, the amended claims do not allow for picolinamide or any other amide at R_{100} . Bennett does not disclose or suggest compounds that contain a moiety other than picolinamide. Patani does not cure these deficiencies. In addition, the amended claims do not allow R and/or R' to recite $-CH_2-CONH_2$, which is required for compound H of Bennett. Therefore, Bennett and Patani, alone or in combination, do not disclose or suggest the compounds of the currently claimed invention. Nothing in Bennett and/or Patani remotely suggests the compounds of amended claims 1 and 8-13.

Therefore, applicants respectfully request that the Office withdraw the rejections of claims 1 and 8-13 based on 35 U.S.C. § 103(a).

Rejections under 35 U.S.C. § 112, 1st paragraph

A. The Office rejected claims 1-16, and 20 under 35 U.S.C. § 112, 1st paragraph for allegedly lacking enablement. In particular, the Office asserts that "[t]he specification does

not enable any skilled pharmacologist or physician to use the invention commensurate in scope with these claims." Applicants respectfully disagree. Nevertheless, in order to expedite the prosecution, Applicants have limited the scope of the claims to address the Examiner's concerns.

Thus, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 112, 1st paragraph rejections of claims 1-3, 8-12, and 20.

B. The Office rejected claim 19 under 35 U.S.C. § 112, 1st paragraph for allegedly lacking enablement. Applicants respectfully disagree; however, in order to expedite the prosecution, Applicants have limited the scope of claim 19. Therefore, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 112, 1st paragraph rejections of claim 19.

Allowance of the claims and passage of the case to issue are respectfully solicited. The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-0001, if she believes that a discussion would expedite prosecution of this application.

Respectfully submitted,

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